

Appln. No. 09/506,434

Response dated December 8, 2004

Response to Office Action mailed on September 8, 2004

REMARKS

Applicants hereby file this Response to the Office Action mailed on September 8, 2004. Claims 1, 4, 10, 11, 13, 15, 17, 21 and 50-59 are pending. The specification has been objected to because the figure descriptions in the specification are not in agreement with the drawing labels in the figures. *See* Office Action at ¶ 5. Further, the specification has been objected to because the references to "data" and "information" are not consistent. *See* Office Action at ¶ 5. Claim 15 has been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. *See* Office Action at ¶ 7. Claims 1, 4, 10, 11, 13, 50-54 and 56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,819,236 to Josephson ("Josephson") in view of U.S. Patent No. 5,751,842 to Riach et. al. ("Riach"). *See* Office Action at ¶ 9. Claims 15, 17, 55 and 59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of U.S. Patent No. 5,933,816 to Zeanah et. al. ("Zeanah"). *See* Office Action at ¶ 10. Claims 21, 57 and 58 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of U.S. Patent No. 6,012,048 to Gustin et. al. ("Gustin"). *See* Office Action at ¶ 11. Applicants have also been requested to add a computer to the preamble of claims 15, 21, 55 and 59 to show that the method is performed using a computer. *See* Office Action at ¶ 9.

I. Objections to the Specification.

The specification has been objected to because the figure descriptions in the specification are not in agreement with the drawing labels in the figures. *See* Office Action at ¶ 5. Further, the specification has been objected to because the references to "data" and "information" are not consistent. The specification has been amended to address these objections. Please note that the term "Data" has been added at p. 7, line 16 and p. 9, line 4, but the underlining of the added terms is not clear since they have been added to section titles which themselves are underlined. Replacement drawings have also been submitted. Specifically, Fig. 1 has been amended to reference "Clearing Houses 131"; "Federal Reserve Banks 132"; "Local Paying Banks 134"; and "Non-local Paying Banks 133" in accordance with the description of Fig. 1 in the Specification at p. 7, lines 7-11. Fig. 2 has been amended to reference "Receive Check 200"; "Log on to BOFD System 210"; "Enter Requested Data 230"; "Supply Missing Data 240"; "Submit

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Transaction to BOFD System for Processing 250"; "Receive Response 270"; and "Check Actions 280" in accordance with the description of Fig. 2 in the Specification at p. 7, line 17 to p. 8, line 20. Fig. 3 has been amended to reference "Logon Request 300"; "Security Function for Authorized User 305"; "Terminate Process for Unauthorized User 310"; "Determine Method for Clearing Check 345"; and "Format Transaction for ECP 360" in accordance with the description of Fig. 3 in the Specification at p. 9, lines 5-22. Applicants respectfully submit that the specification currently references item 315 of Fig. 3 as the part of the process where transaction data is received, and therefore this item has not amended this item. See Specification at p. 9, line 9. Withdrawal of these objections is therefore respectfully requested.

II. Rejection under 35 U.S.C. § 112, second paragraph.

Claim 15 has been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, Claim 15 has been rejected on the grounds that "it is vague or unclear who or what receives a result of the transaction for a check . . . Does the customer receive the result of the transaction for a check or does the banking system receive a result of the transaction of a check?" See Office Action at ¶ 7. Claim 15 has been amended to clarify that the bank customer receives a result of the transaction of the check, and requests that this rejection be withdrawn.

III. Rejections under 35 U.S.C. § 103(a).

A. Rejection of claims 1, 4, 10, 11, 13, 50-54 and 56 over Josephson in view of Riach.

Claims 1, 4, 10, 11, 13, 50-54 and 56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Riach. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 1, 4, 10, 11, 13, 50-54 and 56 and therefore do not form a *prima facie* case of obviousness.

It is stated that Josephson in combination with Riach teaches each and every element of claim 1. See Office Action at ¶ 9. Josephson discloses an electronic system and method for providing advance notification of a potential return that may occur when a presenting financial

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institution ("FI") eventually presents an item for payment to a paying FI in a subsequent paper-based presentment process. *See* Abstract. The invention addresses deficiencies of the prior art, for example the delay that occurs between the time is deposited at a sending FI and the time the paying FI pays the money to the sending FI. *See* col. 2, lines 28-33. During this delay, the sending FI must either place a hold on the check depositor's account for the amount of the check, or else incur the risk that the paying FI will reject the check. *See* col. 2, lines 31-36. However, federal law imposes time limits on the length of time a sending FI can retain a hold on depositor's funds. *See* col. 2, lines 40-45. The invention addresses these deficiencies by maintaining a database of restricted account data. *See* col. 4, lines 24-27. When a sending FI captures item data from an item, such as a deposited check, the item data are checked against the restricted account data to determine whether the item is drawn on an account that the paying FI has restricted. *See* col. 4, lines 27-31. The only disclosure in Josephson regarding methods and sources of deposits into a sending FI are those currently used in a "conventional, paper-based presentment process . . . beginning with a deposit of items by a depositor with the sending FI." *See* col. 7, line 66 to col. 8, line 2. These deposited items "are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines ('ATMs'), mail or lockboxes." *See* col. 8, lines 2-7.

It is stated that the limitation of "an interface to a customer terminal, the customer terminal being located remotely from a bank" is disclosed at Josephson at col. 6, lines 52-67 and Fig. 1. *See* Office Action at ¶ 9. Applicants respectfully submit that this cited section of Josephson does not disclose a customer terminal. Rather, this cited section of Josephson discloses a "PC 100 that provides an environment within which the present invention may operate." *See* col. 6, lines 52-54. Josephson does not disclose that the invention is operable by a customer. Rather, Josephson discloses that the inventive process is operable in the host computer of a sending FI in which captured data from an item are compared to a database containing eligibility criteria and FI restricted account data corresponding to eligible FI depositor accounts. *See* col. 7, lines 45-50. Riach also does not disclose, nor is it asserted that Riach discloses, "an interface to a customer terminal, the customer terminal being located remotely from a bank." Therefore, this limitation is not disclosed in a combination of Josephson and

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Riach, and this combination of references does not form a *prima facie* case of obviousness of the invention of claim 1.

Similarly, in the cited sections of Josephson and Riach, there is no disclosure of an automated banking system connected to a customer terminal interface via a communication link. See Office Action at ¶ 9, citing col. 7, lines 1-51; Figs. 2, 3, 5. Rather, col. 7, lines 1-51 discloses the PC of Fig. 1; there is no disclosure that this PC is operable as a customer terminal. Fig. 2 of Josephson discloses a "block diagram of an architecture of the PC of Fig. 2 that serves as an environment within which the present invention can operate." See col. 7, lines 1-3. Fig. 3 of Josephson discloses a "schematic block representation of a MICR capture and processing process . . . performed at a sending FI, in which the captured item data are compared to a database containing eligibility criteria and restricted account data corresponding to eligible FI depositor accounts." See col. 7, lines 44-50. Fig. 5 of Josephson discloses a schematic block diagram of a report generation process . . . performed at the sending FI for creating a report of any potential return of unpaid checks." See col. 11, lines 34-37. Therefore, the limitation of an automated banking system connected to a customer terminal interface via a communication link is not disclosed in a combination of Josephson and Riach, and this combination of references does not form a *prima facie* case of obviousness of the invention of claim 1.

Since at least the first two limitations of claim 1 are not disclosed by either of Josephson or Riach, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to "have the automated banking system configured such that information from a conventional check is entered into the customer terminal, and wherein the automated banking system and check clearing system are configured to effectuate deposit of the discrete value of each check into an account of the customer payee and to modify in Josephson . . . [which] would allow Josephson to have a funds transfer operation that is effected wherein the value of the cheque is transferred from the payer's account to the payee's account." See Office Action at ¶ 9. The combination of these references does not teach or suggest a customer terminal remotely located from an automated banking system, or an automated banking system connected to a customer terminal interface via a communication link. Accordingly, Applicants respectfully request that the rejection of claim 1, and dependent claims 4, 10, 11, 13, over Josephson in view of Riach be withdrawn.

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Further, neither Josephson nor Riach disclose each and every element of claim 50. Applicants respectfully submit that neither Josephson nor Riach disclose a customer terminal as claimed in claim 50, much less a customer terminal where access is controlled by the customer. Rather, as stated previously, Josephson does not disclose a customer terminal at all, and there is no disclosure in Riach that the customer controls access to the customer terminal. Neither Josephson nor Riach teach or suggest the claimed inventions, either. Therefore, each and every limitation of claims 50-54 and 56 is not disclosed by Josephson and Riach in combination, and a *prima facie* case of obviousness has not been set forth based on these references. Accordingly, Applicants respectfully request that the rejection of claim 50, and dependent claims 51-53 and 56, over Josephson in view of Riach be withdrawn.

B. Rejection of claims 15, 17, 55 and 59 over Josephson in view of Zeanah.

Claims 15, 17, 55 and 59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Zeanah. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 15, 17, 55 and 59 and therefore do not form a *prima facie* case of obviousness.

It is stated that it would have been obvious to modify Josephson in view of Zeanah to render the invention of claim 15 obvious. Applicants respectfully submit that Josephson in combination with Zeanah does not disclose each and every limitation of claim 15. Applicants previously described the Josephson disclosure in Sec. III(B). It is stated in the Office Action that Josephson teaches receiving conventional checks payable to a bank customer payee and entering transaction data into the customer terminal at col. 6, lines 61-65 and col. 8, lines 1-11 and Fig. 1 (130). See Office Action at ¶ 10. Applicants respectfully submit that, for the reasons stated previously in Sec. III(B), Josephson does not teach a customer terminal at all. Specifically, in these cited sections, Josephson discloses at col. 6, lines 61-65 a PC 100 that provides an environment within which the present invention may operate." See col. 6, lines 52-54. Josephson does not disclose that the invention is operable by a customer. Rather, Josephson discloses that the inventive process is operable in the host computer of a sending FI in which captured data from an item are compared to a database containing eligibility criteria and FI restricted account data corresponding to eligible FI depositor accounts. See col. 7, lines 45-50.

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In contrast to the invention of claim 15, Josephson at col. 8, lines 1-11 discloses only a "conventional, paper-based presentment process . . . beginning with a deposit of items by a depositor with the sending FL" See col. 7, line 66 to col. 8, line 2. These deposited items "are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines ('ATMs'), mail or lockboxes." See col. 8, lines 2-7. There is no disclosure in these cited sections of Josephson of receiving conventional checks payable to a bank customer payee and entering transaction data into the customer terminal.

Zeanah discloses a delivery system and method that allows a financial institution to provide financial services to a plurality of remote devices, such as personal computers, personal data assistants and screen phones. See Abstract. The invention of Zeanah is a single base for interfacing with all types of remote devices, allowing bank customers to access banks from a variety of remote devices or from other countries while reducing the complexity required of the bank's internal computer system. See col. 2, line 4- col. 3, line 23; col. 3, lines 39-48. Also, Zeanah reduces the amount of testing that is required for modifications to the applications that govern the bank's internal computer system. See col. 3, lines 24-48. Zeanah discloses an interface between a bank and a customer's personal computer for performing transactions from a customer's home that are known in the art, such as bill paying and money transfers. See col. 1, lines 58-63. However, Zeanah does not disclose the limitations of receiving conventional checks payable to a bank customer payee and entering transaction data into a customer terminal as in claim 15. Zeanah does not disclose deposits of conventional checks at all, much less from a customer terminal that is remote from an automated banking system and a bank. Therefore, a combination of Josephson and Zeanah does not disclose the invention of claim 15 of entering transaction data from a conventional check into a customer terminal that is remotely situated with respect to a bank and an automated banking system, and processing the discrete value of a check for deposit by the automated banking system. Accordingly, Applicants respectfully request that the rejection of claim 15, and dependent claim 17, under 35 U.S.C. § 103 over Josephson in view of Zeanah be withdrawn.

For the same reasons stated above, Applicants also submit that Josephson in combination with Zeanah does not disclose each and every limitation of claim 55. Specifically, Josephson in combination with Zeanah does not disclose a method for allowing a bank customer to deposit the

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value of a conventional check into a bank account from a remote location comprising entering transaction data from a conventional check into a customer terminal that is remotely located from an automated banking system, and processing the discrete value of each check for deposit by the automated banking system (claim 55) or processing a check deposit transaction initiated by a bank customer at a remote location comprising receiving transaction data of a conventional check payable to a bank customer from a customer terminal that is remotely located from the automated banking system and processing the transaction for the discrete value of the check (claim 59). Neither Josephson nor Zeanah teach or suggest the claimed inventions, either. Accordingly, Applicants respectfully request that the rejection of claims 55 and 59 under 35 U.S.C. § 103 over Josephson in view of Zeanah be withdrawn.

C. Rejection of claims 21, 57 and 58 over Josephson in view of Gustin.

Claims 21, 57 and 58 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Gustin. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 21, 57 and 58 and therefore do not form a *prima facie* case of obviousness.

It is stated that it would have been obvious to modify Josephson in view of Gustin to render the invention of claims 21, 57 and 58 obvious. Applicants respectfully submit that Josephson in combination with Gustin does not disclose each and every limitation of claims 21, 57 and 58. Applicants previously described the Josephson disclosure in Sec. III(B). It is stated in the Office Action that Josephson teaches a method for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location comprising receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system at col. 4, lines 56-65 and col. 5, lines 26-63 and Fig. 1. *See* Office Action at ¶ 11. Applicants respectfully submit that, for the reasons stated previously in Sec. III(B), Josephson does not teach a customer terminal at all, much less receiving a request from a bank customer on a terminal that is remotely located from a bank for authorization to make a transaction using an automated banking system.

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Specifically, Josephson discloses at col. 4, lines 56-65 an electronic system comprising an all items file, the all items file comprising item data, data pertaining to an account number of a depositor presenting the item to the sending FI, and an amount of an associated deposit. Item data is captured by magnetic ink detection circuitry (MICR) or by machine vision, manual or other suitable techniques. See col. 4, lines 47-55. At col. 5, lines 26-63, Josephson discloses certain item data that is ineligible for matching with the FI restricted account data, including item data from money orders, travelers checks, official FI checks, dividend checks, government warrant checks, postal money order checks, rebate checks and return item checks, because these items are drawn and handled in such a way that they are not generally subject to restrictions as are ordinary items such as personal or business checks. This section also discloses comparison circuitry to test the FI account number field for verification prior to comparison to FI restricted account data. In addition, this section discloses a matched item file comprising FI account number field matching the account data, a restriction reason code and a notification selection code indicating a type of notification requested as a means for the sending FI to receive a report of any potential presentment problems concerning the item so that the sending FI can take appropriate protective action. Finally, this cited section discloses a database containing restriction reason codes corresponding to the FI restricted account data that provide detail to the sending FI the nature of the potential return of the item, allowing the sending FI to tailor its protective action. Fig. 1 discloses a PC 100 that provides an environment within which the present invention may operate. See col. 6, lines 52-54.

There is no disclosure in these or any other sections of Josephson of receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system. Rather, Josephson discloses that the inventive process is operable in the host computer of a sending FI in which captured data from an item are compared to a database containing eligibility criteria and FI restricted account data corresponding to eligible FI depositor accounts. See col. 7, lines 45-50. Further, Josephson at col. 8, lines 1-11 discloses a "conventional, paper-based presentment process . . . beginning with a deposit of items by a depositor with the sending FI." See col. 7, line 66 to col. 8, line 2. These deposited items

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"are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines ('ATMs'), mail or lockboxes." See col. 8, lines 2-7.

Gustin discloses an automated banking system for wire transfer of funds with a machine where a user has a card to identify the user as being qualified to use the banking system. See Abstract. The machine is preferably an ATM machine. See *id.* The user may pay for the wire transfer at the ATM. See *id.* The ATM, in addition to performing its usual functions, additionally issues money orders without the presence or assistance of a teller, and may also allow the depositing of cash into the machine and the transferring of money by wire, paying bills or purchasing end user items such as lottery tickets or postage stamps. See col. 4, lines 1-18. Gustin does not, however, disclose the limitations not disclosed by Josephson of allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location comprising receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system. Rather, Gustin discloses depositing a check into an ATM. See col. 12, lines 3-47. The check is inserted into the ATM and the transaction data from the check is detected by a MICR reader. See *id.*; col. 19, line 56- col. 20, line 63. Further, the transaction data that is received in Gustin is *not* received from a bank customer using a terminal that is remotely situated from the bank and the automated banking system, as required in claim 21, but rather is read from the check by a MICR reader located in an ATM. Applicants respectfully submit that the combination of Josephson and Gustin does not disclose each and every limitation of claim 21, and therefore does not form a *prima facie* case of obviousness, and request that this rejection be withdrawn.

For the same reasons discussed above, Josephson in combination with Gustin also does not disclose each and every limitation of claims 57 and 58. As discussed in Sec. III(B), Josephson does not disclose a method for allowing a bank customer to deposit the value of a conventional check into a bank account from a remote location comprising entering transaction data from a conventional check into a customer terminal that is remotely located from an automated banking system, and processing the discrete value of each check for deposit by the automated banking system as claimed in claim 55 from which claims 57 and 58 depend. As set forth previously in Sec. III(B), Josephson does not teach a customer terminal at all. Josephson

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also does not disclose that the invention is operable by a customer. Rather, Josephson discloses that the inventive process is operable in the host computer of a sending FI in which captured data from an item are compared to a database containing eligibility criteria and FI restricted account data corresponding to eligible FI depositor accounts. *See* col. 7, lines 45-50. Further, Josephson at col. 8, lines 1-11 discloses a "conventional, paper-based presentment process . . . beginning with a deposit of items by a depositor with the sending FI." *See* col. 7, line 66 to col. 8, line 2. These deposited items "are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines ("ATMs"), mail or lockboxes." *See* col. 8, lines 2-7. Neither does Gustin disclose a method for allowing a bank customer to deposit the value of a conventional check into a bank account from a remote location comprising entering transaction data from a conventional check into a customer terminal that is remotely located from an automated banking system, and processing the discrete value of each check for deposit by the automated banking system. Rather, Gustin discloses depositing a check into an ATM. *See* col. 12, lines 3-47. The check is inserted into the ATM and the transaction data from the check is detected by a MICR reader. *See id.*; col. 19, line 56- col. 20, line 63. Further, transaction data in Gustin is *not* entered into a customer terminal that is remotely located from the automated banking system and where access to the customer terminal is controlled by the customer payee, as required in claim 55. Rather, transaction data in Gustin is read from a conventional check by a MICR reader located in an ATM. Applicants respectfully submit that the combination of Josephson and Gustin does not disclose each and every limitation of claim 55, and therefore does not form a *prima facie* case of obviousness of claims 57 and 58, and request that this rejection be withdrawn.

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CONCLUSION

Based on this background, Applicants respectfully submit that claims 1, 4, 10, 11, 13, 15, 17, 21, and 50-59 are in condition for allowance and request allowance of the same.

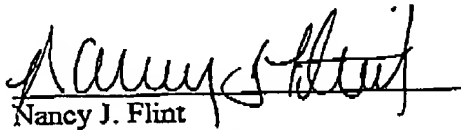
Applicants believe that no fee is due upon the filing of this Response to the Communication. If any fees are found to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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